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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,712	12/11/2001	Mark Paine	9623/378	1404

757 7590 01/19/2005

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,712

Applicant(s)

PAINE ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Status:

Claims 1-64 are pending. Claim 65 has been cancelled. Claims 1-64 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "determining candidate search terms based on search terms of other advertisers on the database system." The specification does not contain a clear and concise computer-implemented method of choosing candidate search terms based on search terms of other advertisers such that the skilled artisan can make and use the invention.

Claim 1 recites "recommending the additional search terms from among the candidate search terms. The specification does not include a clear and concise computer-implemented method of recommending additional search terms selected from the candidate search terms such that the skilled artisan can make and use the invention. For purposes of this Office Action,

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examiner will assume that there exists no difference between candidate search terms and additional search terms.

Claims 2-4 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following:

- receiving a list of search terms associated with an advertiser
- a plurality of search listings which are associated with an advertiser
- at least one search term
- determining candidate search terms based on search terms of other advertisers
- recommending additional search terms from among the candidate search terms

The scope of the invention cannot be determined because the relationship between above search terms/listings is difficult to determine. For purposes of this Office Action, examiner will assume that a first list of search terms drawn from a first web site is compared with a second list of search terms which are derived from web sites other than the first web site.

Claims 2-4 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13, 15, 16, 18, 19, 21-43, 45-49 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,078,916 to Culliss (hereafter Culliss) in view of US Pat No 6,314,420 to Lang et al (hereafter Lang)

Claims 1, 41, 46 and 59:

Culliss discloses:

- receiving a list of search terms [key words, col 17, line 45, col 5, lines 32-35] associated with an advertiser [col 17, lines 43-48] on the database search system, the database search system including a database having stored therein a plurality of search listings [key words, col 17, line 45] which are associated with an advertiser, at least one search term

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[key word col 17, line 45], a money amount [col 17, line 46] and a computer network location [col 4, line 65 – col 5, line 10]

Culliss discloses the essential elements of the claimed invention as noted above except for determining candidate search terms based on search terms of other advertisers on the database search system and recommending the additional search terms from among the candidate search terms. Lang discloses determining candidate search terms based on search terms of other advertisers on the database search system [spider scanning + content filter, col 1, lines 23-26] and recommending the additional search terms from among the candidate search terms [collaborative filtering, col 1, lines 40-45]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Culliss to include determining candidate search terms based on search terms of other advertisers on the database search system and recommending the additional search terms from among the candidate search terms as taught by Lang for the purpose of providing better search responses to user queries [Lang, col 1, lines 10-16].

Claim 2:

The combination of Culliss and Lang discloses the elements of claim 1 as noted above.

The combination of Culliss and Lang discloses assigning ratings to search terms, computing a correlation between the advertiser and one or more of the other advertisers, using the assigned ratings of advertiser search terms [Lang, informons compared to individual user's query, informons are ranked, col 1, line 65 – col 2, line 3]

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Claim 3:

The combination of Culliss and Lang discloses the elements of claims 1 and 2 as noted above and furthermore discloses predicting a likelihood that a candidate search term will be relevant to the advertiser [Lang, Fig 1, 33]

Claim 4:

The combination of Culliss and Lang discloses the elements of claims 1-3 as noted above and furthermore discloses determining a quality metric for the candidate search terms and predicting relevance of candidate search terms based on the quality metric [Lang, ranking col 1, line 65 – col 2, line 4]

Claim 5:

Culliss discloses maintaining a database of search listings, each search listing being associated with an advertiser and including associated search terms[col 17, line 45, col 5, lines 32-35], a money amount [col 17, line 46] and a computer network location [col 4, line 65 – col 5, line 10], receiving a list of search terms associated with an advertiser [key words, col 17, line 45, col 5, lines 32-35]

Culliss discloses the essential elements of the claimed invention as noted above except for computing ratings for search terms and recommending additional search terms to the advertiser based on the computed ratings. Lang discloses computing ratings for search terms and recommending additional search terms to the advertiser based on the computed ratings [col 1, line 65 – col 2, line 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Culliss to include computing ratings for search terms and recommending additional search terms to the advertiser based on the computed ratings as taught

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by Lang for the purpose of providing better search responses to user queries [Lang, col 1, lines 10-16].

Claim 6 and 47:

The combination of Culliss and Lang discloses the elements of claims 5 and 46 as noted above and furthermore assigning ratings to search terms [Lang, col 1, line 65 – col 2, line 3]

Claims 7 and 48:

The combination of Culliss and Lang discloses the elements of claims 5 and 46 as noted above and furthermore predicting ratings for search terms [Lang, col 1, line 65 – col 2, line 3]

Claim 8:

The combination of Culliss and Lang discloses the elements of claim 8 as noted above and furthermore receiving a list of initial search terms from the advertiser [Lang, col 17, line 45]

Claim 9:

The combination of Culliss and Lang discloses identifying an existing advertiser on the database search system and forming the list of search terms from search terms of the existing advertiser [Lang, col 17, line 45].

Claim 10:

The combination of Culliss and Lang discloses the essential elements of claim 5 and receiving a website URL [Culliss, col 29, lines 30-45].

Claim 11:

The combination of Culliss and Lang discloses the essential elements of claim 5 and receiving data from pages of the website [Lang, col 1, lines 10-15], recording candidate search

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terms from the data [Lang spider scanning + content filter, col 1, lines 23-26], and determining a quality metric for each search term [Lang, ranking, col 1, line 65 – col 2, line 4]

Claims 12:

The combination of Culliss and Lang discloses the elements of claims 5, 10 and 11 and sorting the candidate search terms according to the quality metric and recommending only candidate search terms having a quality metric exceeding a threshold [Lang, col 9, lines 1-15]

Claim 13:

The combination of Culliss and Lang discloses the elements of claims 5 and 10 as noted above Lang discloses receiving data from one or more pages of the site and examining text from the one or more pages for candidate search terms [Lang, col 1, lines 10-16]

Claim 15:

The combination of Culliss and Lang discloses the elements of claims 5, 10 and 13 as noted above and furthermore, receiving the advertiser's URL as the web site URL [Culliss, col 29, lines 30-45].

Claim 16:

The combination of Culliss and Lang discloses the elements of claims 5, 10 and 13 as noted above and furthermore, receiving the web site URL from the advertiser [Culliss, col 29, lines 30-45].

Claim 18:

Culliss discloses a database of search terms, each search term being associated with one or more advertisers, a money amount and a computer network location, the search terms being searchable in response to a query from a user to identify search terms which match the query, matching search listings being returnable to the user in a search result list in which the matching search listings are ordered using the money amounts for the respective matching search listings [key words, col 17, line 45, col 17, lines 43-48]. Culliss discloses the essential elements of the claimed invention as noted above except for program code configured to recommend additional search terms for an advertiser based on search terms in the database program code configured to recommend additional search terms for an advertiser based on search terms in the database [inherent in Fig 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Culliss to include program code configured to recommend additional search terms for an advertiser based on search terms in the database as taught by Lang for the purpose of providing better search responses to user queries [Lang, col 1, lines 10-16].

Claim 19:

The combination of Culliss and Lang discloses the elements of claim 18 as noted above and furthermore discloses collaborative filtering code configured to recommend the additional search terms based on search terms associated with other advertisers of the database search system [Lang, Fig 4, 260].

Claim 21:

The combination of Culliss and Lang discloses the elements of claims 18 and 19 as noted above and furthermore the program code comprises a program loop [Lang, Fig 4].

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Claim 22:

The combination of Culliss and Lang discloses the elements of claims 18, 19 and 21 as noted above and furthermore, code to accept indications or reject indications from the advertiser before repeating the program loop [Lang Fig 3, step 115].

Claim 23:

The combination of Culliss and Lang discloses the elements of claims 18 as noted above and furthermore, spidering code to recommend the additional search terms [Lang, col 1, lines 60-65]

Claim 24:

The combination of Culliss and Lang discloses the elements of claim 18 as noted above and furthermore, spidering code to find initially accepted search terms in a web site; and collaborative filtering code to provide the recommended additional search terms [receiving a data stream from a computer network, [Lang col 1, line 45 – col 2, line 3].

Claim 25:

The combination of Culliss and Lang discloses the elements of claims 18 and 24 as noted above and furthermore, wherein the spidering code is configured to spider a web site of the advertiser [Lang col 1, line 45 – col 2, line 3].

Claim 26:

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The combination of Culliss and Lang discloses the elements of claims 18 and 23 as noted above and furthermore, wherein the spidering code is configured to spider a web site specified by the advertiser [Lang, col 1, line 45 – col 2, line 3].

Claim 27:

The combination of Culliss and Lang discloses the elements of claims 18 as noted above and furthermore, filtering code to filter candidate search terms according to a quality metric to produce the recommended additional search terms [Lang, Fig 6, 427, 430 432].

Claim 28:

The combination of Culliss and Lang discloses the elements of claims 5, 10, 13 and 15 as noted above and furthermore, search engine program code configured to search the database in response to a search query from a user [Lang, information filtering per col 8, lines 4-13].

Claim 29:

The combination of Culliss and Lang discloses spidering a specified web site to obtain an initial list of advertiser search terms for an advertiser [Lang col 1, line 45 – col 2, line 3], filtering the initial list of advertiser search terms using search terms of other advertisers [Lang col 1, line 45 – col 2, line 3], storing in a search listing database search listings for the advertiser [Lang, Fig 1, 31], the search listings formed with the filtered search terms [Lang col 1, line 45 – col 2, line 3], the search listing database being searchable by a search engine web server which identifies listings having a search term matching a search query entered by a user [Lang, Fig 3], orders the identified listings using advertiser bid amounts associated with the search term

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in the search listing and generates a result list including at least some of the ordered listings

[Culliss col 17, lines 43-48]

Claim 30:

The combination of Culliss and Lang discloses the elements of claim 29 as noted above and furthermore, wherein the specified web site comprises an advertiser specified website [Lang, col 2, lines 20-27, web sites are inherently advertiser web sites]

Claim 31:

The combination of Culliss and Lang discloses the elements of claim 29 as noted above and furthermore, wherein the specified web site comprises a web site specified by the database search system [Lang, col 2, lines 20-27].

Claim 32:

The combination of Culliss and Lang discloses the elements of claim 29 as noted above and furthermore, assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers and using the assigned ratings of advertiser search terms [Lang, informons compared to individual user's query, informons are ranked, col 1, line 65 – col 2, line 3]

Claim 33:

The combination of Culliss and Lang discloses the elements of claims 29 and 32 as noted above and furthermore, predicting a likelihood that a search term will be relevant to the advertiser [Lang , Fig 1, 33]

Claim 34:

The combination of Culliss and Lang discloses the elements of claims 29, 32 and 33 as noted above and furthermore, determining a quality metric for candidate search terms and predicting a relevance of candidate search terms based on the quality metric [Lang, ranking col 1, line 65 – col 2, line 4]

Claim 35:

The combination of Culliss and Lang discloses the elements of claims 29 as noted above and furthermore, wherein spidering the specified web site comprises: receiving data from pages of the specified website [Lang, inherently disclosed in internet connections of claim 88]; recording candidate search terms from the data [Lang, information filtering per col 8, lines 4-13]; and determining a quality metric for each candidate search term [Lang, Fig 6, 427, 430, 432].

Claim 36:

The combination of Culliss and Lang discloses the elements of claims 29 and 35 as noted above and furthermore, sorting the candidate search terms according to the quality metric and recommending only candidate search terms having a quality metric exceeding a threshold [Lang, col 9, lines 1-15].

Claim 37:

The combination of Culliss and Lang discloses the elements of claims 29 as noted above and furthermore, determining a correlation between a web site of the advertiser and web sites of other advertisers on the database system [Lang, Fig 4, 260], using the correlation [Lang, Fig 4, 260], determining ratings for each advertiser search term in the initial list of the advertiser search terms and organizing search terms of the initial list of advertiser search terms according to the ratings [Lang, Fig 6, 427, 430 and 432].

Claims 38 and 39:

The combination of Culliss and Lang discloses the elements of claims 29 as noted above and furthermore, presenting the organized search terms to the advertiser and receiving advertiser acceptance indications for the organized search terms [Lang, presenting the proposed informon to the user, col 4, lines 43-63], adjusting the list of advertiser search terms according to the acceptance indications, filtering the adjusted list [Lang, adapting the content profile per col 4, lines 43-63].

Claim 40:

The combination of Culliss and Lang discloses the elements of claims 29 and 38 as noted above and furthermore, receiving a search query from a user [Lang, col 1, lines 10-15], searching for matching search terms in the search listing database [col 1, lines 15-33], preparing search results by formatting search terms according to advertiser bid amounts associated with the matching search listings [Culliss, col 17, lines 43-48], communicating the search results to the user [Fig 2, 64b]

Claim 42:

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The combination of Culliss and Lang discloses the elements of claim 41 as noted below and furthermore, matching one or more text strings from the received search term with a database of search terms [Lang, Fig 3]

Claim 43:

The combination of Culliss and Lang discloses the elements of claims 38 and 29 as noted above and furthermore, matching one or more text strings from the received term with a thesaurus [Lang, col 13, lines 35-50]

Claim 45:

The combination of Culliss and Lang discloses entering the selected search term as a default value in each of the one or more search listings [Lang, user profile per col 7, lines 31-54].

Claim 49:

The combination of Culliss and Lang discloses the elements of claim 46 as noted above and furthermore, computing correlations for the advertiser and the other advertisers based on the information describing the advertiser and information describing the other advertisers [Lang, Fig 6, 432], and recommending search terms based at least in part on the correlations [Lang, Fig 6, 432]

Claims 51-55:

The combination of Culliss and Lang discloses downloading web pages rooted at a specified uniform resource locator (URL) [Culliss col 29, lines 30-45] and recommending to an

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advertiser who maintains search listings in the pay for placement market system search terms that appear in the body text of the web pages [Lang col 1, line 45 – col 2, line 3]

Claim 56:

The combination of Culliss and Lang discloses calculating a quality metric for candidate search terms, the quality metric for a respective candidate search term being a function of the respective search term's web frequency and a function of a search term's search frequency [Lang, col 10, lines 20-45] and recommending search terms for which the calculated quality metric exceeds a threshold [Lang, col 9, lines 1-15] .

Claim 57:

The combination of Culliss and Lang discloses the elements of claim 56 as noted above and furthermore, a second metric [Lang, collaborative filtering, col 2, lines 5-20].

Claim 58:

The combination of Culliss and Lang discloses the elements of claim 56 as noted above and furthermore, automatically calibrating the quality threshold [col 9, lines 1-20].

Claim 60:

The combination of Culliss and Lang discloses the elements of claim 59 as noted above and furthermore, determining candidate search terms by collaborative filtering and recommending search terms from the candidate search terms [Lang, col 1, line 45 – col 2, line 3]

Claims 61 and 62:

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The combination of Culliss and Lang discloses the elements of claim 59 as noted above and furthermore, downloading web pages rooted at a uniform resource locator and recommending the search terms based on terms that appear in body text of the web pages [Culliss col 29, lines 30-45]

Claim 63:

The combination of Culliss and Lang discloses the elements of claims 59 and 63 and furthermore, calculating a quality metric for candidate search terms, the quality metric for a respective candidate search term being a function of the respective search term's web frequency and a function of a search term's search frequency, and recommending the search terms based on search terms for which the calculated quality metric exceeds a quality threshold [Lang, col 9, lines 1-21]

Claim 64:

The combination of Culliss and Lang discloses the elements of claim 59 as noted above and furthermore, receiving feedback from the advertiser on the recommended search terms; and changing the recommended search terms based on the feedback [Lang, col 4, lines 55-60].

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lang and Culliss and further in view of US Pat No 6,141,010 to Hoyle (hereafter Hoyle).

Claim 14:

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The combination of Lang and Culliss discloses the elements of claims 5, 10 and 13 as noted above but fails to disclose examining meta tags from the one or more pages. Hoyle discloses examining meta tags from the one or more pages [col 15, line 54 through col 16, line 8]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Lang and Culliss to include examining meta tags from the one or more pages as taught by Hoyle. The ordinarily skilled artisan would have been motivated to modify the combination of Lang and Culliss per the above for the purpose of obtaining key words which are embedded in a web page.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lang and Culliss in view of US Pat No 6,078,866 issued to Buck et al (hereafter (Buck)).

Claim 17:

The combination of Lang and Culliss discloses the elements of claim 5 as noted above. The combination of Lang and Culliss fails to disclose preparing search results by formatting matching search terms according to advertiser bid amounts associated with the search listings; and communicating the search results to the user. Buck discloses preparing search results by formatting matching search terms according to advertiser bid amounts associated with the search listings; and communicating the search results to the user [claim1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Culliss and Lang to include preparing search results by formatting matching search terms according to advertiser bid amounts associated with the search listings; and communicating the

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search results to the user as taught by Buck. The ordinarily skilled artisan would have been motivated to modify the combination of Culliss and Lang per the above for the purpose of providing a means for generating revenue for the internet service provider.

Claims 20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Culliss and Lang in view of US Pat No 5,872,850 to Klein et al (hereafter Klein).

Claim 20:

The combination of Culliss and Lang discloses the essential elements of the claimed invention as noted above in claims 18, 19 and except for assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers using the assigned ratings of advertiser search terms. Klein discloses assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers using the assigned ratings of advertiser search terms [col 10, lines 9-34]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Culliss and Lang to include assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers using the assigned ratings of advertiser search terms as taught by Klein for the purpose of determining a similarity factor between two users [col 10, lines 9-13].

Claim 50:

The combination of Lang and Culliss discloses the elements of claims 18, 19, 46 and 49 as noted above. The combination of Lang and Culliss fails to disclose wherein the collaborative filtering code comprises Pearson correlation code. Klein discloses wherein the collaborative filtering code comprises Pearson correlation code [col 10, lines 9-34]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Culliss and Lang to include wherein the collaborative filtering code comprises Pearson correlation code as taught by Klein. The ordinarily skilled artisan would have been motivated to modify the combination of Culliss and Lang per the above for the purpose of determining a similarity factor between two users [col 10, lines 9-13].

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lang and Culliss in view of US Pat No 5,799,268 to Boguraev.

Claim 44:

The combination of Lang and Culliss discloses the elements of claim 41 as noted above. The combination of Lang and Culliss fails to disclose displaying a form for entering one or more search listings for a selected search term. Boguraev discloses displaying a form for entering one or more search listings for a selected search term [Fig 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Culliss and Lang to include displaying a form for entering one or more search listings for a selected search term as taught by Boguraev. The ordinarily skilled artisan would have been motivated to

modify Lang per the above for the purpose of providing a convenient means of inputting user data.

Response to Arguments

Applicant's arguments filed 8/4/2004 with respect to claims 1-64 have been considered but are moot in view of above new ground(s) of rejection necessitated by applicant's amendment. Nevertheless, it is expedient to consider the gist of applicant's comments.

Applicant Argues:

Applicant states in the third paragraph on page 15 "Lang is completely unrelated to a pay for placement marketplace. Lang actually relates to information filtering in a computer system receiving a data stream from a computer network. Entities of information relevant to a user, called 'informons,' are extracted from the data stream. Column 6, line 66 – column 7, line 4. Lang does not disclose any features of a pay for placement marketplace, such as advertisers, bid amounts, search listings, etc.

Examiner Responds:

Examiner is nt persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pay for placement marketplace and bid amounts) are not recited in the amended claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant Argues:

Applicant states in the third paragraph on page 16 "Thus, unlike the method and apparatus of amended claims 1-64 which relate to a pay for placement system relying on bid amounts chargeable to the system operator for an event such as a clickthrough, Buck instead discloses a subscription service."

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a pay for placement system relying on bid amounts chargeable to the system operator for an event such as a clickthrough) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consider the following claim 1 limitation "at least one search term, a money amount and a computer network" in light of Buck's disclosure, col3, line 52 through column 4, line 39 which is reproduced as following:

It is therefore a principal object of the present invention to devise a method and system for **Internet searching and indexing in which Web site owners can determine for themselves the rankings that their information or services should receive in competition with others**, and not through computation of a ranking based on arbitrary factors or subjective determination by a search service. It is a further object that the Web site owners be able to readily upgrade or downgrade their rankings based upon their assessment of market factors on an on-going basis. It is also desirable that this system be readily implemented at manageable cost and readily understood by users without having to accept a new search orthodoxy or unfamiliar change of search usage.

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In accordance with the present invention, a method and system of network site searching and listing comprises a listing server connected to a network accessible by a plurality of users, having a site listings database containing a plurality of site listings, each of which is provided by a site listing subscriber and includes a title or description of the content of the respective site, a network address at which the site can be accessed on the network, and a **denominated value to be paid by the subscriber associated with the site listing while it is maintained on the listing server**, wherein said listing server provides a search report of listings relevant to a search inquiry from a user in which the listings are ranked in order according to the denominated values associated with the listings.

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In the preferred embodiment, subscribers pay a monetary amount of their own choosing as a subscription fee to list a site with the listing service for a defined subscription period. The higher the amount paid for a given subscription period in relation to other listers, the higher the site's ranking on the service's search reports. Subscribers can monitor the ranking of their listings in relation to others, and can modify their rankings by raising or lowering their subscription fees, through a subscription monitoring interface provided with the listing server. Changes to the subscription fees, and consequently to the rankings, may be handled by the listing service at defined adjustment intervals, such as daily, weekly, monthly, etc. The denominated value may be based upon a monetary value, or even a credit or point system, depending upon the type of subscriber base being solicited by the listing service.

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The denominated-value approach to rankings may also be used in conjunction with the index search method or the category search method. In the first case, an index search of the listing service's database is performed using keywords, and the resulting listings found are ranked according to their subscription fee values. In the second case, the subscribers' listings are assigned to appropriate categories, then when the user inputs a selection of categories of interest, the resulting listings found are ranked according to their subscription fee values.

Examiner maintains that above disclosure by Buck reads on the claims 1 limitation "at least one search term, a money amount and a computer network location."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US Pub No 2003/0088554 to Ryan et al discloses content providers bidding for different keywords and profile types.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

1/10/2005



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